

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Michael S. Brown, et al.

Serial No.: Unknown

Filed: Concurrently Herewith

For: METHOD OF TREATMENT OF A
HUMAN WITH A FARNESYL
TRANSFERASE INHIBITOR

Group Art Unit: Unknown

Examiner: Unknown

Atty. Dkt. No.: UTSD:249USC1/DLP

1c971 U.S. PTO
10/083894

02/27/02

CERTIFICATE OF EXPRESS MAIL

NUMBER EL611000113US

DATE OF DEPOSIT September 19, 2000

I hereby certify that this paper or fee is being deposited with the United States Postal Service "EXPRESS MAIL POST OFFICE TO ADDRESSEE" service under 37 C.F.R. 1.10 on the date indicated above and is addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

Signature

INFORMATION DISCLOSURE STATEMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In compliance with the duty of disclosure under 37 C.F.R. § 1.56, it is respectfully requested that this Information Disclosure Statement be entered and the documents listed on attached Form PTO-1449 be considered by the Examiner and made of record. Copies of the listed documents required by 37 C.F.R. § 1.98(a)(2) are enclosed for the convenience of the Examiner.

In accordance with 37 C.F.R §§ 1.97(g),(h), this Information Disclosure Statement is not to be construed as a representation that a search has been made, and is not to be construed to be

an admission that the information cited is, or is considered to be, material to patentability as defined in 37 C.F.R. § 1.56(b).

This application is a continuation application of Serial No. 07/937,893, filed December 22, 1992 and is relied upon for an earlier filing date under 35 U.S.C. § 120. In accordance with Rule 37 C.F.R. § 1.98(d) copies of the listed documents are not enclosed as they have been previously cited by or submitted to the Patent and Trademark Office in prior application Serial No. 07/937,893.

REMARKS

This paper is also filed to bring to the Examiner's attention a family of related applications which are currently undergoing examination in the Patent and Trademark Office, have been issued as a US patent or have been abandoned. Applicants wish to disclose this information for the convenience of the Examiner in considering the present application.

The status of the applications believed to be relevant to the present discussions are set forth below in Table I.

Table I. Status of the Applications


| Serial or Patent No. | Filing Date / Issue Date | Inventors | Status | History |
|------------------------------|---------------------------------|--------------------------|---|-------------------|
| 07/510,706 | Apr. 18, 1990 | Brown, Goldstein & Reiss | Abandoned | Parent |
| 5,141,851 | Nov. 20, 1990 / Aug. 25, 1992 | Brown, Goldstein & Reiss | Issued | CIP of 07/510,706 |
| 07/937,893 PCT/US91/02650 | Apr. 18, 1991 | Brown, Goldstein & Reiss | Pending – Involved in Interference No. 103,586 | CIP of 07/510,706 |
| 07/822,011 | Jan. 16, 1992 | Brown, Goldstein & Reiss | Abandoned | CIP of 07/510,706 |
| 5,420,245 | Apr. 3, 1992 / May 30, 1995 | Brown, Goldstein & Reiss | Issued | DIV of 07/822,011 |

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|-----------|---------------------------------|--|--------|---|
| 6,083,917 | Aug. 24, 1992 / July 4, 2000 | Brown, Goldstein, Reiss & Marsters | Issued | CIP of 07/822,011 |
| 5,976,851 | Feb. 16, 1993 / Nov. 2, 1999 | Brown, Goldstein & Reiss | Issued | CIP of 07/822,011 |
| 5,962,243 | Apr. 27, 1995 / Oct. 5, 1999 | Brown, Goldstein & Guy | Issued | |
| 5,843,941 | Sept. 26, 1994 Dec.1, 1998 | Marsters, Brown, Goldstein et al. | Issued | Unrelated to 07/822,011, but to related subject matter |
| 5,532,359 | Oct. 25, 1994 / July 2, 1996 | Marsters, Brown, Goldstein et al. | Issued | Unrelated to 07/822,011, but to related subject matter |

This Information Disclosure Statement is being filed prior to the receipt of the First Official Action reflecting an examination on the merits, and hence is believed to be timely filed in accordance with 37 C.F.R. § 1.97(b). No fees are believed to be due in connection with the filing of this Information Disclosure Statement, however, should any fees be deemed necessary, the Commissioner is hereby authorized to deduct said fees from Fulbright & Jaworski Deposit Account No. 50-1212/UTSD:249USC1/DLP.

Applicants respectfully request that the listed documents be made of record in the present case.

Respectfully submitted,



David L. Parker
Reg. No. 32,165
Attorney for Applicant

FULBRIGHT & JAWORSKI, L.L.P.
600 Congress Avenue, Suite 1900
Austin, Texas 78701
(512) 418-3000

Date:

9/19/00

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| Form PTO-1449 (modified) | Atty. Docket No. UTSD: 249USC1 | Serial No. UNKNOWN |
| List of Patents and Publications for Applicant's INFORMATION DISCLOSURE STATEMENT (Use several sheets if necessary) | Applicant Michael S. Brown et al. | |
| | Filing Date: 9/14/00 | Group: UNKNOWN |

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U.S. Patent Documents

| Exam. Init. | Ref. Des. | Document Number | Date | Name | Class | Sub Class | Filing Date of App. |
|-------------|-----------|-----------------|----------|------------------------|-------|-----------|---------------------|
| | A1 | 5,532,359 | 07/02/96 | Marsters, Jr. et. al. | 540 | 522 | 10/25/94 |
| | A2 | 6,083,917 | 07/04/00 | Brown, et. al. | 514 | 18 | 08/24/92 |
| | A3 | 5,976,851 | 11/02/99 | Brown, et. al. | 435 | 193 | 02/16/93 |
| | A4 | 5,962,243 | 10/05/99 | Brown, et. al. | 435 | 15 | 04/27/95 |
| | A5 | 5,843,941 | 12/01/98 | Marsters, Jr., et. al. | 514 | 221 | 09/26/94 |
| | A6 | 5,420,245 | 05/30/95 | Brown, et. al. | 530 | 328 | 04/03/92 |
| | A7 | 5,141,851 | 08/25/92 | Brown, et. al. | 435 | 15 | 11/20/90 |

Foreign Patent Documents

| Exam. Init. | Ref. Des. | Document Number | Date | Country | Class | Sub Class | Translation Yes/No |
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| | B1 | | | | | | |
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Other Art (Including Author, Title, Date Pertinent Pages, Etc.)

| Exam. Init. | Ref. Des. | Citation |
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| | C1 | |
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EXAMINER:

DATE CONSIDERED:

EXAMINER: INITIAL IF REFERENCE CONSIDERED, WHETHER OR NOT CITATION IS IN CONFORMANCE WITH MPEP609; DRAW LINE THROUGH CITATION IF NOT IN CONFORMANCE AND NOT CONSIDERED. INCLUDE COPY OF THIS FORM WITH NEXT COMMUNICATION TO APPLICANT.

INFORMATION DISCLOSURE STATEMENT — PTO-1449 (MODIFIED)

Form PTO-1449 (modified)ATTY. DOCKET NO.
UTSD:249USD1 /PARSERIAL NO.
UnknownList of Patents and Publications
For Applicant's Information
Disclosure StatementAPPLICANT
Michael S. Brown et al.

(Use several sheets if necessary)

FILING DATE 9/19/00 GROUP
Unknown**U.S. PATENT DOCUMENTS**

| EXAM. INIT. | REF. DES. | DOCUMENT NUMBER | DATE | NAME | CLASS | SUB CLASS | FILING DATE IF APPROPRIATE |
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| | B10 | 0 461 869 A2 | 12/18/91 | Europe | | | |
| | B11 | WO 91/16340 | 10/31/91 | PCT | | | |
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OTHER ART (Author, Title, Journal, Volume, Pertinent Pages, & Date)

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| | C25 | International Search Report, mailed January 24, 1994. |
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EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

Information Disclosure Statement--PTO-1449 (Modified)

Form PTO-1449 (modified)

ATTY. DOCKET NO.
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UnknownList of Patents and Publications
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Disclosure StatementAPPLICANT
Michael S. Brown et al.

(Use several sheets if necessary)

FILING DATE 9/14/00

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| | A9 | 5,245,061 | 09/14/93 | Sheo B. Singh | 554 | 121 | 12/16/91 |
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| Form PTO-1449 (modified) List of Patents and Publications For Applicant's Information Disclosure Statement (Use several sheets if necessary) | ATTY. DOCKET NO. | SERIAL NO. |
| | UTSD:249USD1 /PAR | Unknown |
| | APPLICANT Michael S. Brown et al. | |
| | FILING DATE 9/14/00 | GROUP Unknown |

U.S. PATENT DOCUMENTS

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| | A6 | 5,104,975 | 04/14/92 | McCormick et al. | 530 | 350 | 07/08/88 |
| | A7 | 5,234,839 | 08/10/93 | McCormick et al. | 436 | 501 | 03/20/91 |
| | A8 | 5,238,922 | 08/24/93 | Graham et al. | 514 | 18 | 09/30/91 |
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Brown, et al.

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U.S. PATENT DOCUMENTS

| EXAM. INIT. | REF. DES. | DOCUMENT NUMBER | DATE | NAME | CLASS | SUB CLASS | FILING DATE IF APPROPRIATE |
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| | B2 | 0 535 731 | 04/07/93 | Europe | | | |
| | B3 | 0 535 730 | 04/07/93 | Europe | | | |
| | B4 | 0 528 486 | 02/24/93 | Europe | | | |
| | B5 | 0 523 873 | 01/20/93 | Europe | | | |
| | B6 | 0 520 823 | 12/30/92 | Europe | | | |
| | B7 | 2 261 375 | 05/19/93 | UK | | | |
| | B8 | 2 261 374 | 05/19/93 | UK | | | |
| | B9 | 2 261 373 | 05/19/93 | UK | | | |

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| ✓ | C24 | Nancy E. Kohl, et al., "Selective Inhibition of ras-Dependent Transformation by a Farnesyltransferase Inhibitor", Science, 260:1934-1937 (1993) |
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| | A5 | 5,202,456 | 04/13/93 | Rando | 558 | 438 | |
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| | UTSD:249USD1 / PAR | Unknown |
| | APPLICANT Brown et al. | |
| | INTERNATIONAL FILING DATE 9/19/00 | GROUP Unknown |

U.S. PATENT DOCUMENTS

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| | A1 | 5,043,268 | 1991 | Stock | | | |
| | A2 | 5,055,487 | 10/8/91 | Bartizal, et al. | 514 | 452 | |
| | A3 | 5,026,554 | 06/25/91 | Bartizal, et al. | 424 | 404 | |

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| | B1 | 0 456 180 A1 | 11/13/91 | EUROPE | | | |

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| | C1 | Clarke et al., "Posttranslational modification of the Ha-ras oncogene protein: Evidence for a third class of protein carboxyl methyltransferases," <i>Proc. Natl. Acad. Sci. USA</i> , <u>85</u> :4643-4647, 1988 |
| | C2 | Hancock et al., "All ras Proteins Are Polyisoprenylated but Only Some Are Palmitoylated," <i>Cell</i> , <u>57</u> :1167-77, 1989 |
| | C3 | Schafer et al., "Genetic and Pharmacological Suppression of Oncogenic Mutations in RAS Genes of Yeast and Humans," <i>Science</i> , <u>245</u> :379-385, 1989 |
| | C4 | Bos, "ras Oncogenes in Human Cancer: A Review," <i>Cancer Research</i> , <u>49</u> :4682-4689, 1989 |
| | C5 | Lowy et al., "New Clue to Ras lipid glue," <i>Nature</i> , <u>341</u> :384-85, 1989 |
| | C6 | Casey et al., "p21ras is modified by a farnesyl isoprenoid," <i>Proc. Natl. Acad. Sci. USA</i> , <u>86</u> :8323-8327, 1989 |
| | C7 | Goldstein et al., "Regulation of the mevalonate pathway," <i>Nature</i> , <u>343</u> :425-430, 1990 |
| | C8 | Schaber et al., "Polyisoprenylation of Ras in Vitro by a Farnesyl-Protein Transferase," <i>J. of Biol. Chem.</i> , <u>265</u> :14701-14704, 1990 |
| | C9 | Manne et al. "Identification and preliminary characterization of protein-cysteine farnesyltransferase," <i>Proc. Natl. Acad. Sci. USA</i> , <u>87</u> :7541-7545, 1990 |

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| Form PTO-1449 (modified) List of Patents and Publications For Applicant's Information Disclosure Statement (Use several sheets if necessary) | ATTY. DOCKET NO. UTSD:249USD1 | SERIAL NO. Unknown |
| | APPLICANT Brown, et al. | |
| | DATE 9/19/00 | FILING GROUP ART UNIT Unknown |

U.S. PATENT DOCUMENTS

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| C10 | Reiss et al., "Inhibition of Purified p21ras Farnesyl:Protein Transferase by Cys-AAX Tetrapeptides," <i>Cell</i> , 62:81-88, 1990 |
| C11 | Reiss et al., "Sequence requirement for peptide recognition by rat brain p21ras protein farnesyltransferase," <i>Proc. Natl. Acad. Sci. USA</i> , 88:732-736, 1991 |
| C12 | Chen, et al., "cDNA Cloning and Expression of the Peptide-Binding β Subunit of Rat p21ras Farnesyltransferase, the Counterpart of Yeast DPR1/RAM1," <i>Cell</i> , 66:327-334, 1991 |
| C13 | Goldstein, et al., "Nonfarnesylated Tetrapeptide Inhibitors of Protein Farnesyltransferase," <i>J. Biol. Chem.</i> , 266(24):15575-15578, 1991 |
| C14 | Goodman, et al., "Structure and Expression of Yeast DPR1, a Gene Essential for the Processing and Intracellular Localization of ras Proteins," <i>Yeast</i> , 4:271-281, 1988 |
| C15 | Goodman, et al., "Mutants of <i>Saccharomyces cerevisiae</i> defective in the farnesylation of Ras proteins," <i>Proc. Natl. Acad. Sci. USA</i> , 87:9665-9669, 1990 |
| C16 | Schaber, et al., "Polyisoprenylation of Ras in vitro by a farnesyl-protein transferase," <i>Chem. Abstr.</i> , 114:302, Abstract # 38170r, 1991 |
| C17 | Kim, et al., "Prenylation of mammalian Ras protein in <i>Xenopus</i> oocytes," <i>Chem. Abstr.</i> , 114:373, Abstract # 3711r, 1991 |
| C18 | Kohl et al., "Structural Homology among Mammalian and <i>Saccharomyces cerevisiae</i> Isoprenyl-protein Transferases," <i>J. Biol. Chem.</i> , 266(28):18884-18888, 1991 |

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| C19 | He et al., "RAM2, an essential gene of yeast, and RAM1 encode the two polypeptide components of the farnesyltransferase that prenylates a-factor and Ras proteins," <i>Proc. Natl. Acad. Sci. USA</i> , <u>88</u> :11373-11377, 1991 |
| C20 | International Search Report |
| C21 | Reiss, et al., "Divalent Cation and Prenyl Pyrophosphate Specificities of the Protein Farnesyltransferase from Rat Brain, a Zinc Metalloenzyme," <i>J. Biol. Chem.</i> , <u>267</u> :6403-6408, 1992 |
| C22 | Seabra, et al., "Protein Farnesyltransferase and Geranylgeranyl transferase Share a Common α Subunit," <i>Cell</i> , <u>65</u> :429-434, 1991 |
| C23 | Reiss, et al., "Purification of ras Farnesyl:Protein Transferase," <i>Methods: A Companion to Methods in Enzymology</i> , <u>1(3)</u> :241-245, 1990 |

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